

PATENT COOPERATION TREATY

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From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

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PATENT DEPARTMENT

04 APR 2005

PCT

WRITTEN OPINION OF THE
INTERNATIONAL PRELIMINARY
EXAMINING AUTHORITY
(PCT Rule 66)

Date of mailing
(day/month/year) **31.03.2005**

Applicant's or agent's file reference
PC20548A

REPLY DUE **within 2 month(s)**
from the above date of mailing

International application No. PCT/IB2004/001120	International filing date (day/month/year) 31.03.2004	Priority date (day/month/year) 14.04.2003
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International Patent Classification (IPC) or both national classification and IPC
C07D207/327, C07D405/06

Applicant
WARNER-LAMBERT COMPANY LLC et al.

- ☒ The written opinion established by the International Searching Authority:
☒ is ☐ is not
considered to be a written opinion of the International Preliminary Examining Authority
- This second report contains indications relating to the following items:
☒ Box No. I Basis of the opinion
☐ Box No. II Priority
☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
☐ Box No. IV Lack of unity of invention
☒ Box No. V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
☐ Box No. VI Certain documents cited
☐ Box No. VII Certain defects in the international application
☐ Box No. VIII Certain observations on the international application
- The applicant is hereby invited to reply to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(e).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also: For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4bis. For an informal communication with the examiner, see Rule 66.6. For an additional opportunity to submit amendments, see Rule 66.4.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.
- The final date by which the international preliminary report on patentability (Chapter II of the PCT) must be established according to Rule 69.2 is: **14.08.2005**

Name and mailing address of the International preliminary examining authority:


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**WRITTEN OPINION OF THE INTERNATIONAL
PRELIMINARY EXAMINING AUTHORITY**International application No.
PCT/IB2004/001120**Box No. I Basis of the opinion**

1. With regard to the **language**, this opinion is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
 - ☐ This opinion is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
 - ☐ international search (under Rules 12.3 and 23.1(b))
 - ☐ publication of the international application (under Rule 12.4)
 - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements** of the international application, this opinion is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed")*:

Description, Pages

1-36 as originally filed

Claims, Numbers

1-11 filed with telefax on 06.12.2004

- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
 - ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing (*specify*):
 - ☐ any table(s) related to sequence listing (*specify*):
 4. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
 - ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing (*specify*):
 - ☐ any table(s) related to sequence listing (*specify*):

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**Box No. V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or
industrial applicability; citations and explanations supporting such statement**

1. Statement

Novelty (N)	Yes: Claims	1-11
	No: Claims	
Inventive step (IS)	Yes: Claims	1-11
	No: Claims	
Industrial applicability (IA)	Yes: Claims	1-11
	No: Claims	

2. Citations and explanations:

see separate sheet

Re Item V

**Reasoned statement with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement**

- D1: US-B1-6 476 235 (NELSON JADE DOUGLAS ET AL) 5 November 2002 (2002-11-05)
- D2: E. FALOMIR ET AL.: "Stereoselective synthesis of spicigerolide"
TETRAHEDRON LETTERS, vol. 44, 13 January 2003 (2003-01-13), pages
539-541, XP002294837 ELSEVIER SCIENCE PUBLISHERS, AMSTERDAM.
NL
- D3: P. B. GREER ET AL.: "Synthetic studies directed toward the phorboxazoles:
preparation of the C3-C15 bisoxane segment and two stereoisomers"
TETRAHEDRON, vol. 58, 22 June 2002 (2002-06-22), pages 6009-6018,
XP002294838 ELSEVIER SCIENCE PUBLISHERS, AMSTERDAM. NL

Formal matters, clarity

With the present claims Applicant has obviously tried to overcome the objections raised by the ISA in the Annex to the ISR.

The claims are entirely based on either original claims 1-11 or the description and are thus allowable under Art 34(2)(b) PCT. The correction of some clerical errors in claim 1 is in line with Rule 91 PCT.

However, it appears, that with the present claims further obscurity has been introduced.

What is the purpose of new claim 6? Which process does the claim refer to? Formula VII is not in line with Formula VII of claim 11 and Formula VII of the description (see e.g. page 12).

"Chiral auxiliary" (claims 8 and 9) lacks clarity. Does it address the optional use of a chiral Lewis acid (see e.g. description, page 21, lines 9 and 15)?

Does claim 9 refer to claim 6?

Does claim 10 refer to claim 7?

Moreover, it appears that claim 10 is still suffering from the same clerical errors which have

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already been objected by the ISA.

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It remains furthermore unclear, how compounds IX and X in claim 11 contribute to solve the problem underlying the claimed subject-matter. Since these compounds and the remaining compounds of claims 1-10 are apparently not linked together by one single inventive concept, namely the provision of a process for the preparation of a compound of Formula (I), it appears to be very likely that the presence of these compounds could give rise to non-unity.

Novelty, inventive step, industrial applicability

For the subject-matter underlying the present claims now on file, in principle, novelty, inventive step and industrial applicability have been already acknowledged by the ISA.